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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
GRAYSAY, TAMARA L	
ART UNIT	**PAPER NUMBER**
3623	

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/748,579	BRACCHITTA ET AL.	
	Examiner	Art Unit	
	Tamara L. Graysay	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 March 2005 and 27 June 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13,15-41,43-54 and 56* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13,15-41,43-54 and 56* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 June 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The amendment filed 18 March 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The new matter added by amendment to the claims is the recited "priority" value assigned to the technology areas of interest. Applicant has not particularly pointed out the basis for the newly added limitation, but rather generally refers to the discussion at page 6, line 14 – page 8, line 8; page 12, line 16 – page 13, line 28; and page 15, lines 23-26, as well as Figures 1-4. At page 6, third paragraph, there is mention of apportioning resource capacity, however, the resource capacity is apportioned within the budgeting process and the division of resources is based on an "ideal" management process, not technology areas of interest. A percentage of total resource is allocated to each "major area," as mentioned at the last sentence on page 6, however, the discussion does not prioritize the percentage to the technology areas or define a priority value.

A review of the entire disclosure does not reveal support for the claimed value as a priority value. While the disclosure at page 8, second paragraph, mentions resource constraints 44, the discussion does not make any reference to "priority" values based on the technology areas of interest, but instead mentions constraints related to money, time units, capacity, and other measures. Further, the disclosure mentions at page 9, second paragraph, that technologists can identify and "prioritize" specific *opportunities* requiring invention development, the

prioritization is not related to apportioning or allocating available resource capacity based on a priority value assigned to each technology area of interest, as recited in amended claim 1 and its dependent claims. New matter of similar scope has been added to claims 15, 31, 43 and 56, and their dependent claims.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-13, 15-24, 31-41, 43 and 56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The new matter added by amendment to the claims is the recited "priority" value assigned to the technology areas of interest. Applicant has not particularly pointed out the basis for the newly added limitation, but rather generally refers to the discussion at page 6, line 14 – page 8, line 8; page 12, line 16 – page 13, line 28; and page 15, lines 23-26, as well as Figures 1-4. At page 6, third paragraph, there is mention of apportioning resource capacity, however, the resource capacity is apportioned within the budgeting process and the division of resources is based on an "ideal" management process, not technology areas of interest. A percentage of total

resource is allocated to each "major area," as mentioned at the last sentence on page 6; however, the discussion does not prioritize the percentage to the technology areas or define a priority value.

A review of the entire disclosure does not reveal support for the claimed value as a priority value. While the disclosure at page 8, second paragraph, mentions resource constraints 44, the discussion does not make any reference to "priority" values based on the technology areas of interest, but instead mentions constraints related to money, time units, capacity, and other measures. Further, the disclosure mentions at page 9, second paragraph, that technologists can identify and "prioritize" specific *opportunities* requiring invention development, the prioritization is not related to apportioning or allocating available resource capacity based on a priority value assigned to each technology area of interest, as recited in amended claim 1 and its dependent claims. New matter of similar scope has been added to claims 15, 31, 43 and 56, and their dependent claims.

For the above reasons, doubt is raised as to applicant's possession of the claimed invention at the time of filing.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claim1-13, 15-30, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu (article, Managing the university technology licensing process: findings from case studies).

a. Regarding claim 1, Hsu discloses a method for managing resource allocations within an intellectual property portfolio comprising determining resource capacity (potential value of a licensed invention contrasted with the human resources needed to develop and process invention disclosures, patents, licenses, etc.) for an intellectual property activity (for example, invention disclosures that are patented and licensed); assigning technology tags (disclosed technology fields or tags include promising, potentially important, and embryonic technologies, p.1, ¶3) representing different technology areas of interest (it is inherent in Hsu that the various disclosures reviewed by a licensing officer are from different technologies due to the diversity of research and development within academia and the university setting); apportioning available resource capacity (decisions to file a patent application for or to license an invention disclosure) to different technology areas of interest (the examiner takes Official notice that the diverse technologies in academia and the resultant resource allocations are based on many factors including, but not limited to, the interests of the university and its research staff and that the resources generated by a research university are affected by the receipt of federal grants and private funding) based on a priority value for each technology area of interest (unworthwhile, scarce marketing resources, etc., p.3, ¶3); obtaining actual resource usage (licensing officer, inventor or faculty time, office staff) by technology area; and employing the tracking system to provide a report indicative of the difference between the actual resource usage and the resource allocation by technology area of interest for managing resource

allocation for the intellectual property activities (decision to file patents for invention disclosures, and decision to pursue license(s) for patented inventions) for the activity. Hsu discloses a tracking system and report generation capabilities insofar as the universities that were studied provided statistics summarizing their activities.

Hsu lacks a computer tracking system.

A computer is a well-known expedient used to track information in a more accurate and more rapid manner. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the determining step of Hsu to include a computer tracking system, in order to obtain more accurate results faster. Furthermore, it is well settled that it is not "invention" to broadly provide a mechanical or automatic means to replace manual activity that accomplishes the same result. *In re Venner*, 120 USPQ 192.

b. Regarding claims 2-4, Hsu discloses that the license office can be classified on the basis of a commitment spectrum and that decisions to allocate resources are based on various factors including historical data. This disclosed process of using historical data to make patent activity managing decisions inherently includes a determination between actual resource usage and apportioned, or allocation, resources within a time period. As noted regarding claim 1 above, Hsu includes assigning technology tags with the technology areas of interest (disclosed technology fields or tags include promising, potentially important, and embryonic technologies, p.1, ¶3).

c. Regarding claim 5-8, Hsu discloses a dynamic adjustment of the apportioned resource (commitment decision based on whether disclosure is likely to be in the top half of disclosures received, p.2, ¶3) and the use of periodic reports insofar as at least yearly summaries are mentioned. One example provided by Hsu is yearly statistics (longer time period) that are periodically compared to the current year (shorter time period) as noted on p.2, ¶3.

d. Regarding claims 9, 19, and 27, Hsu discloses historical and current time frames. Generally, the time frames are intended to compare the current year's invention disclosures with historical data. For example, at page 2, ¶3, if 50 % is the historical amount of patent applications filed for invention disclosures, then the current year invention disclosures are reviewed keeping in mind the historical amount of 50%. In this example, the first time period is the current year and the second time period, thus Hsu lacks the second time period including the first time period. The examiner takes official notice that data is routinely analyzed over a time period suitable for the particular analysis, and that it is notorious in the field of administrative analysis to use a particular time period including weekly, biweekly, monthly, bi-monthly, quarterly, annually, semi-annually, etc. The time period manipulation of data in any manner suitable for analysis by the institution would have been obvious to one of ordinary skill in the art of operations research. For example, an institution that has had a change in administration or budget would also include the first time period in the second time period to view the overall affect that the administrative or budget change has on the institutional technology office,

or simply to analyze the current fiscal year or to compare the current fiscal year to a prior fiscal year or years. Regarding claims 9, 19, and 27, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hsu so that the first time period is less than five months and the second time period is at least two times the first time period, in order to analyze a snap shot for institution reporting purposes. For example, the second quarter of a fiscal year compared to the first half of the fiscal year, or the third quarter of the fiscal year compared to the first three quarters of the fiscal year, and the like.

e. Regarding claims 10 and 28, the claimed time frames are commensurate with standard reporting for accounting purposes. A two to four month time period would accommodate quarterly analysis. For example, a first quarter analysis compared to the first quarter average over the past three years, a third quarter analysis as compared to the first three quarters, or the last quarter compared to the overall year.

f. Regarding claim 11, Hsu includes evaluating invention disclosures, for example.

g. Regarding claims 12-13, Hsu discloses setting intellectual property development guidelines that are commensurate with the goals of the university and understanding the current intellectual property portfolio insofar as the goals include royalty revenue and the benefit of the current technology to the related business or marketplace. As noted regarding claim 1 above, Hsu includes assigning technology tags (disclosed technology

fields or tags include promising, potentially important, and embryonic technologies, p.1, ¶3).

h. Regarding claim 15, Hsu discloses a method for managing invention disclosures comprising determining a desired number of invention disclosures based on available resources (invention disclosures are based on the number of faculty, the technology office staffing, and budget); apportioning desired number of invention disclosures by a plurality of technology tags based on a priority value assigned to each technology area of interest (decisions to file a patent application for or to license an invention disclosure based on technology fields or tags include promising, potentially important, and embryonic technologies, p.1, ¶3; and the value of technologies, p.4, last paragraph); tracking actual number of disclosures and comparing actual with desired disclosures; and proactively managing the invention disclosure evaluation (marketing strategy P.7). Hsu discloses a tracking system and report generation capabilities insofar as the universities that were studied provided statistics summarizing their activities.

Hsu lacks a computer tracking system.

A computer is a well-known expedient used to track information in a more accurate and more rapid manner. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the determining step of Hsu to include a computer tracking system, in order to obtain more accurate results faster. Furthermore, it is well settled that it is not "invention" to broadly provide a

mechanical or automatic means to replace manual activity that accomplishes the same result. *In re Venner*, 120 USPQ 192.

i. Regarding claims 16 and 20, Hsu discloses a tracking system that periodically generates a report of the actual and desired invention disclosures insofar as the Hsu data provided annual summaries of the invention disclosures for several universities. The intended use of the information, to facilitate proactive managing is met by Hsu because it is capable of such use.

j. Regarding claim 17, Hsu discloses a report for a first time period that is the previous year, and a second time period that is the current year (commitment decision based on whether disclosure is likely to be in the top half of disclosures received, p.2, ¶3) and the use of periodic reports insofar as at least yearly summaries are mentioned. One example provided by Hsu is yearly statistics that are periodically compared to the current year as noted on p.2, ¶3, i.e., the first time period is longer than the second time period.

k. Regarding claims 18 and 26, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify Hsu to include analysis where the second time period is inclusive of the first time period. An institution that has a goal of increasing patent application filings would include the first time period in the second time period in order to determine whether the patent application filings for the current year have any impact on the overall historical data.

l. Regarding claim 21, Hsu discloses technical attributes comprise a technology-based descriptor (disclosed technology fields or tags include promising, potentially important, and embryonic technologies, p.1, ¶3).

m. Regarding claim 22, as noted with regard to claim 20 above, Hsu discloses proactively managing comprising adjusting invention disclosure evaluation.

n. Regarding claim 23, Hsu discloses the invention of claim 23 as noted with regard to claims 15-22 above.

o. Regarding claim 24, Hsu discloses setting intellectual property development guidelines that are commensurate with the goals of the university and understanding the current intellectual property portfolio insofar as the goals include royalty revenue and the benefit of the current technology to the related business or marketplace.

p. Regarding claims 25 and 30, Hsu discloses a first set of data representing actual resource usage over a first time period (current year) and a second set of data representing actual resource usage over a second time period (historical data, longer time period). The data is compared to facilitate resource allocation management. The intellectual property activity comprises at least evaluating invention disclosures.

q. Regarding claim 29, Hsu discloses a third set of data representing budget goals for a given time period (p.1, ¶2).

r. Regarding claim 43, Hsu inherently includes an apparatus including means for determining a desired number of invention disclosures and means for apportioning the desired number based on value assigned to a technology tags, representing different technology areas of interest (see p.3, ¶2-4 for a discussion of invention disclosures and their technology tags that will help maximize a university's social benefit, avoid a stigma of non-discriminatory technological pursuits, and balance risk). Hsu discloses a tracking system that is inherent to the process insofar as the universities that were studied provided statistics summarizing their activities. Hsu also discloses means for proactively managing invention disclosure evaluation (technologies licensing offices decide to pursue by filing for a patent, p.1, ¶3). Hsu discloses a tracking system and report generation capabilities insofar as the universities that were studied provided statistics summarizing their activities.

Hsu lacks a computer tracking system.

A computer is a well-known expedient used to track information in a more accurate and more rapid manner. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the determining step of Hsu to include a computer tracking system, in order to obtain more accurate results faster. Furthermore, it is well settled that it is not "invention" to broadly provide a

mechanical or automatic means to replace manual activity that accomplishes the same result. *In re Venner*, 120 USPQ 192.

4. Claims 31-41; 44-54; and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nummelin (US-6308164) in view of Hsu (article, Managing the university technology licensing process: findings from case studies).

Nummelin discloses a tracking apparatus for managing a project. The apparatus includes means for determining resource capacity (development of a project plan, c.7, l.46-56; resources within the organization or enterprise, c.2, l.10-14; c.2, l.55-61; c.3, l.64-67; c.4, l.5; c.5, l.44-46, etc.); means for assigning technology tags, representing areas of interest, (secondary category/type information, c.2, l.10-14, ref.330) to an activity; means for apportioning resource capacity to areas of interest (reference is made to resource capacity apportioning with respect to assigning tasks generally, e.g., c.2, l.19-44); means for obtaining actual resource usage (each task is defined in terms of resources used, c.5, l.43-50); and means for employing computer tracking to provide a report indicative of actual resource use compared to allocated resources by managing resource allocation for a project (project managers monitor project and task status, project resources receive task assignments and input task status at workstations, c.5, l.65-c.6, l.1). Nummelin includes project tracking using a computer system (information recorded in fields, e.g., c.2, l.19-44).

Nummelin lacks the intellectual property activity.

Hsu teaches an analysis of an intellectual property portfolio and the activities within and related to the portfolio.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Nummelin to include data related to an intellectual property portfolio, as taught by Hsu, in order to effectively manage the invention disclosures within the portfolio and to analyze the resources allocated to maintain the portfolio.

Further regarding claims 44-54 and 56, the apparatus of Nummelin, as modified by Hsu, includes a computer readable storage device (localized and secondary databases, ref.112, 116, 122, 124, 132, 134) that is capable of performing the process as recited in the claims.

Response to Arguments

5. Applicant's arguments filed 18 March 2005 and 27 June 2005 have been fully considered but they are not persuasive. The arguments have been considered to the extent that they apply to the new ground of rejection.

Applicant argues claim 1, by example, that Hsu lacks assigning technology tags to the activity in a computer tracking system. The examiner points out in detail in the above rejection that the assigning of technology tags is met by Hsu's assignment to various categories. The term technology tag is not limited by the definition given by applicants but rather by the plain meaning of the term. The plain meaning of the term technology tag is merely a reference point for the taxonomy used to categorize the various types of activities. The fact that the activities are

related to a technology is met by the categories of promising, potentially important, and embryonic technologies, i.e., promising technologies, potentially important technologies, and embryonic technologies. The issue of computerizing a manual system is not invention as set forth in case law, e.g., *In re Venner*.

Further applicant argues that Hsu fails to uncover a teaching of apportioning available resource capacity based on the priority value assigned to technology area of interest. Temporarily putting aside the new matter objection and rejection, the Hsu reference includes apportioning insofar as the surveyed university technology licensing offices were able to provide statistical information for their search strategies and patent application filing practices.

Further applicant argues that Hsu fails to include a report. The examiner addresses that issue in the rejection above. The use of reports is common in business and is not an inventive step. The Hsu reference is a report in and of itself, not to mention the fact that reports are used throughout the business industry to record information and analyze information.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is (571) 272-6728. The examiner can normally be reached on Mon - Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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